IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : David Wong   Art Unit   : 3691
Serial No. : 10/632,701   Examiner : Lalita M. Hamilton
Filed   : July 31, 2003   Conf. No. : 3616

Title   : COMPLIANCE RULES FOR DYNAMIC BIDDING

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

<u>REPLY BRIEF</u>

Pursuant to 37 C.F.R. § 41.41, Applicant responds to the Examiner's Answer of
February 28, 2011, as follows:

Status of the Claims

Claims 1-37 are pending, stand rejected under 35 U.S.C. § 103(a), and are presently
under appeal. Claims 1, 12, 16, and 27 are independent claims. Applicant is appealing the
rejections of all pending claims.

Grounds of Rejection to be Reviewed on Appeal

Claims 1-6, 8-9, 12-21, 23-24, 27-32 and 34-35 stand rejected under 35 U.S.C. § 103(a)
as being unpatentable over Spencer (U.S. Patent No. 6,356,909) in view of Albazz (U.S. Patent
Publication No. 2002/0046081); claims 7, 22 and 33 stand rejected under 35 U.S.C. § 103(a) as
being unpatentable over Spencer and Albazz as applied to claims 1 and 16, and in further view of
Lee (U.S. Patent Publication No. 2002/0615814); and claims 10-11, 25-26 and 36-37 stand
rejected under 35 U.S.C. § 103(a) as being unpatentable over Spencer and Albazz as applied to
claims 1, 16 and 27, and in further view of Tenrorio (U.S. Patent Publication No.
2003/0208424). Applicant is appealing all of these rejections.

Arguments

The Examiner addresses three issues in response to Applicant's arguments. *See*
Examiner's Answer at pp. 8-10. Applicant will comment on the three issues in order.

**1. The Examiner asserts that Spencer and Albazz together disclose "receiving user
input...," as recited in independent claim 1.**

The Examiner asserts that Spencer and Albazz, when combined, disclose "receiving user
input to associate a particular compliance rule with the opportunity, the user input specifying a
particular response attribute of a plurality of response attributes to be evaluated according to the
particular compliance rule, the user input further specifying the particular compliance rule of a
plurality of pre-defined compliance rules," as recited in claim 1. *See* Examiner's Answer at p. 9.
In support of this allegation, the Examiner states that Spencer discloses that "[t]he user inputs
attributes of RFP [request for proposal] and responses to the RFP are inputted into the system –

col. 8, lines 5-38 – and evaluating according to compliance rules taught by Albazz." Examiner's Answer at p. 9.

However, the Examiner's allegation appears to not take into account some features in claim 1. It is plain legal error to read a feature entirely out of a claim, or to ignore a feature that is positively recited in a claim. *See Pause Technology LLC v. Tivo Inc.*, 419 F.3d 1326, 1334 (Fed. Cir. 2005) (rejecting claim construction that would ignore claim term "predetermine"); *Maxwell v. J. Baker, Inc.*, 86 F.3d 1098, 1105 (Fed. Cir. 1996) (refusing to adopt a claim construction that would ignore a claim limitation); *Texas Instruments, Inc. v. United States Int'l Trade Comm'n*, 988 F.2d 1165, 1171 (Fed.Cir.1993) (providing "to construe the claims in the manner suggested by TI would read an express limitation out of the claims. This we will not do").

For example, the Examiner's analysis appears to ignore "receiving user input <u>to associate a particular compliance rule with the opportunity</u>," where the "opportunity represent[s] a desired commercial transaction," as recited in claim 1 (emphasis added). The Examiner's allegation does not address this claim feature. Instead, the Examiner appears to only address the portion of claim 1 that is recited after this feature and that provides "the user input specifying a particular response attribute of a plurality of response attributes to be evaluated according to the particular compliance rule." For instance, the Examiner asserts that Spencer discloses "[t]he user inputs attributes of RFP and responses to the RFP are inputted into the system [at] col. 8, lines 5-38," and that Albazz discloses "evaluating according to compliance rules." Examiner's Answer at p. 9. However, the Examiner does not indicate where Spencer or Albazz disclose or suggest "user input to associate a particular compliance rule with the opportunity," as recited in claim 1.

The portion of Spencer cited by the Examiner (col. 8, lines 5-38) does not disclose or suggest "receiving user input to associate a particular compliance rule with the opportunity," as recited in claim 1. Instead, this portion of Spencer is directed to providing a user interface for entering or selecting a question to create a request for proposal (RFP). For example, Spencer states that "the user is provided with the web interface 1," Spencer at 8:15-16, and that "RFP questionnaires are compiled by using the Question database via the Internet 221 (in FIG. 1) where selections are made by the RFP creator to create a completed RFP." Spencer at 8:22-24.

Spencer further states that "[t]o create the RFP, RFP creators may search the Question database using a database search program and select from a set of related questions from the Question database, from edited existing questions, from newly created questions, or from any combination of the three." Spencer at 8:25-30. Nowhere in col. 8, lines 5-38, does the Spencer reference disclose or suggest "receiving user input to associate a particular compliance rule with the opportunity," as recited in claim 1.

As such, Applicant submits that the Examiner has erred by not taking into account explicitly recited features in claim 1.

2. The Examiner asserts that Spencer discloses "electronically receiving a response…," as recited in independent claim 1.

The Examiner asserts that col. 4, lines 49-52 and col. 9, lines 13-15 of Spencer disclose "electronically receiving a response from the potential supplier, the response including response attribute data for the particular response attribute," as recited in claim 1. *See* Examiner's Answer at p. 10.

However, the Examiner's allegation reads features out of claim 1 that are explicitly recited and, thus, the analysis constitutes plain legal error. For instance, the Examiner's allegation ignores the portion of claim 1 reciting that "the response includ[es] response attribute data for the particular response attribute," where the particular response attribute (for which the response attribute data is received) was specified by the received "user input to associate a particular compliance rule with the opportunity" for "evaluat[ion] according to the particular compliance rule," as recited in claim 1.

In contrast, the portions of Spencer that the Examiner cites are directed to responses being posted to a communications network, but Spencer nowhere teaches or suggests that such responses should include "response attribute data for the particular response attribute," as recited in claim 1. For example, the cited portions of Spencer state that "[o]nce the vendors complete the RFP response forms (proposals), the proposals are posted to the communications network for review by the RFP creators for review and analysis," Spencer at 4:49-52, and that "[o]nce the response to the posted RFP is received, the RFP creator reviews and analyzes the response using

a computer program as depicted in step 205." Spencer at 9:13-15. Spencer nowhere teaches or suggests that such responses should "includ[e] response attribute data for the particular response attribute," let alone that they should do so where such a particular response attribute (for which the response attribute data is received) was specified by the received "user input to associate a particular compliance rule with the opportunity" for "evaluat[ion] according to the particular compliance rule," as recited in claim 1.

As such, Applicant submits that the Examiner has committed plain legal error by ignoring features explicitly recited in claim 1.

3. The Examiner asserts that Albazz discloses "using a computer-implemented rules engine...," as recited in independent claim 1.

The Examiner asserts that paragraphs 0056-0059 of Albazz discloses "using a computer-implemented rules engine, evaluating the response attribute data for the particular response attribute using the particular compliance rule," as recited in claim 1. *See* Examiner's Answer at p. 10.

Contrary to the Examiner's allegations, these paragraphs of Albazz do not disclose or suggest "using a computer-implemented rules engine, evaluating the response attribute data for the particular response attribute using the particular compliance rule," as recited in claim 1.

Instead, these paragraphs of Albazz regard creating contracts from sets of terms and conditions (abbreviated in Albazz as "Ts&Cs"). For example, paragraph 0056 of Albazz discusses "a business-to-business e-commerce site or marketplace need[ing] at least one Ts&Cs Set to create contracts" and that "[e]ach Ts&Cs Set represents an integrated set of terms and conditions which can be used selectively by the sales group to prepare and propose contracts to prospective buyer organizations." In paragraph 0057, Albazz provides a list of information that can be included in a "Ts&Cs Set," such as "Ts&Cs identifier or reference number [and] Ts&Cs short description." Paragraphs 0058-0059 of Albazz describe "examples of Ts&Cs Instances [to] illustrate how the Ts&Cs Set can play a focal role in a business-to-business e-commerce site," such as a "[p]ricing" set of terms and conditions that includes information like an "[a]pplicable pricing model," an "applicable % discount by each category," and an "applicable bottom line

discount." Nowhere in paragraphs 0056-0059 does Albazz disclose or suggest "using a computer-implemented rules engine, evaluating the response attribute data for the particular response attribute using the particular compliance rule," as recited in claim 1.

The Examiner does not allege in either the final Office Action of September 26, 2007, or in the Examiner's Answer that the other cited references disclose or suggest this feature.

For at least the foregoing reasons, Applicant submits that cited references do not disclose or suggest "using a computer-implemented rules engine, evaluating the response attribute data for the particular response attribute using the particular compliance rule," as recited in claim 1.

For these reasons, and the reasons stated in the Appeal Brief, Applicant submits that the final rejection should be reversed.

Please apply any charges or credits to Deposit Account No. 06-1050.

                                        Respectfully submitted,

Date:April 28, 2011   /Christopher C. Hoff, Reg. No. 67,738/
                                        Christopher C. Hoff
                                        Reg. No. 67,738

Customer Number 32864
Fish & Richardson P.C.
Telephone: (612) 335-5070
Facsimile: (877) 769-7945

60700630.doc